

REMARKS

The Examiner notes that on page 6 of the response to a non-final office action filed by Applicants on 1/13/2003, that Applicants requested the cancellation of claims 13-19, 23-26, and 28, but asserted on page 10, lines 1-2, that claims 6, 13-21, and 23-30 had been deleted. The Examiner requests clarification of the issue.

Applicants assert herein that claims 6, 13-19, 23-26, and 28 have been previously cancelled. Claims 20-21, 27, and 29-30 were withdrawn from further consideration by the Examiner, referring to 37 CFR 1.142(b), as being drawn to an invention non-elected without traverse in Paper No.11, filed 10/4/2001, and are herewith cancelled without prejudice. Claims 1, 4, 7-9, 22, 32-33 and 35-39 have been amended, and claims 5 and 34 have been cancelled without prejudice. Therefore, claims 1-4, 7-12, 22, 31-33 and 35-39 are now pending. Support for the amendments may be found throughout the specification, for example on page 7, lines 25-29 and on page 13, lines 11-17. No new matter has been added by virtue of the amendments.

Applicants gratefully acknowledge the office's indication that claims 2-4 and 38-39 are allowed.

FORMAL MATTERS

Applicants gratefully acknowledge the acceptance of the inventorship correction and the acceptance of the formal drawings.

CLAIM OBJECTIONS

Claim 22 was objected to because of the term "a nucleic acid molecule of any one of claims..." The Examiner suggested the use of the term "the nucleic acid molecule of any one of claims..."

Applicants have presently amended claim 22, as recommended by the Examiner. Applicants respectfully request reconsideration and withdrawal of the foregoing objection.

Claim 33 was objected to since it depends upon a rejected base claim.

As described in the remarks below, Applicants have amended the base claim (claim 1) upon which claim 33 depends. Thus, by having obviated the rejections to claim 1, reconsideration and withdrawal of the objection is respectfully requested.

35 U.S.C. §112, 2<sup>ND</sup> PARAGRAPH REJECTIONS

Claims 5, 6 and 22 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Specifically, the Examiner states that claim 5 is indefinite in the recitation of "complement thereof" as it is unclear which complements are encompassed by the claim. Additionally, the Examiner states that claim 5 is indefinite in the recitation of "nucleic acid comprising a fragment of at least 3500 nucleotides which encodes a polypeptide comprising a fragment of the amino acid sequence of SEQ ID NO:2." The Examiner states claim 6 was rejected due to the recitation of "molecule hybridizes to a nucleic acid molecule...under stringent conditions.

In the interest of expediting prosecution, and without acquiescing to the Examiner's rejection, Applicants have cancelled claim 5 and confirmed the cancellation of claim 6, thereby obviating the 35 U.S.C. 112, 2<sup>nd</sup> paragraph rejection of claims 5 and 6.

Finally, the Examiner states that claim 22 is indefinite in the recitation of "molecule of any one of claims 1, 2, 3, 4, or 5 to a compound" as being unclear what the meaning of the term is within the context of the claim. Additionally in claim 22, the recitation of "...65°C, to a compound" was deemed unclear.

Applicants have amended claim 22, as recommended by the Examiner, to read "A kit comprising the nucleic acid molecule of any one of claims 1, 2, 3, or 4 which selectively hybridizes in 0.5M sodium phosphate, 7% SDS at 65°C, followed by one or more washes in 0.2 X SSC at 65°C, to a nucleic acid molecule and instructions for use." Applicants respectfully request reconsideration and withdrawal of the foregoing rejection.

35 U.S.C. §112, 1<sup>ST</sup> PARAGRAPH REJECTIONS

Claims 1, 4-12, 22, 31-32, and 34-37 were rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner states this is a new matter rejection, since the Examiner has been unable to locate support in the

specification, as originally filed, for polynucleotides comprising specifically nucleotides 63-4991 of SEQ ID NO:1 or variants thereof as encompassed by the claims.

Applicants have amended the specification in order to correct errors in nucleic acid and amino acid numbering with respect to the sequence listing. Support for these amendments can be found in Figure 1 of the original application, which correctly depicted the location of the open reading frame, but contained errors in the nucleic acid numbering of the open reading frame. Such corrections do not introduce new matter. However, in an attempt to expedite prosecution of the instant application, and in no way acquiescing to the Examiner's rejection, Applicants have amended claims 1, 4, 32 and 35-37 to reflect the correct coding region of nucleotides 63-5012 for SEQ ID NO:1. Claims 5, 6, and 34 have been cancelled thus rendering the rejection as to these claims moot. In light of these amendments and claim cancellations, Applicants respectfully request reconsideration and withdrawal of the foregoing rejection.

In sections 12-16 of the Office Action, claims 5-12, 22 and 31 were rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the Examiner states "[w]hile the specification has disclosed the polynucleotide of SEQ ID NO:1 and the polypeptide of SEQ ID NO:2 as well as its function, there is no disclosure of the structure and function of (1) a 3500 nucleotide fragment of a nucleic acid comprising the polynucleotide of SEQ ID NO:1..., (2) a 3500 nucleotide fragment of a nucleic acid which encodes a polypeptide..."

In the interest of expediting prosecution, and without acquiescing to the Examiner's rejection, Applicants have cancelled claim 5 and confirmed the cancellation of claim 6, thus rendering the rejection as to these claims moot. Additionally, Applicants have amended claims 7-9 and 22 to depend upon a pending base claim that does not recite the language for which the Examiner contends there is no support. Applicants respectfully request reconsideration and withdrawal of the foregoing rejection.

In sections 17-21 of the Office Action, claims 5-12, 22 and 31 were rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a nucleic acid (1) consisting of at least 3500 nucleotides of SEQ ID NO:1, (2) consisting of at least 3500

nucleotides of 63-4991 of SEQ ID NO:1, or (3) comprising a fragment of the polynucleotide of SEQ ID NO:1 wherein said fragment encodes a polypeptide having kinase activity, does not reasonably provide enablement for a nucleic acid comprising a fragment of at least 3500 nucleotides of a nucleic acid comprising (1) the polynucleotide of SEQ ID NO:1 or (2) nucleotides 63-4991 of SEQ ID NO:1. Specifically, the Examiner states that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with the claims.

In the interest of expediting prosecution, and without acquiescing to the Examiner's rejection, Applicants have cancelled claim 5 and confirmed the cancellation of claim 6, thus rendering the rejection as to these claims moot. Applicants have amended claims 7-9 and 22 to depend upon a pending base claim. Applicants respectfully request reconsideration and withdrawal of the foregoing rejection.

35 U.S.C. §102(a) REJECTION

Claims 4-12 and 22 were rejected under 35 U.S.C. 102(a) as being anticipated by Berlanga et al. (cited in the IDS) and Duesterhoeft et al. (cited in the IDS). The Examiner states that the rejection has been maintained for claim 6 due to the conflicting statements in page 6 and page 10, lines 1-2 of the response. In regards to claims 4-5, 7-12 and 22, the rejection was withdrawn.

Applicants gratefully acknowledge the withdrawal of the rejection in regards to claims 4-5, 7-12, and 22. Applicants herein confirm the cancellation of claim 6 and respectfully request the rejection be withdrawn.

CONCLUSIONS

In view of the amendments and remarks made herein, Applicants respectfully submit that the objections and rejections presented by the Examiner are now overcome and that this application is now in condition for allowance. Early notice to this effect is solicited.

If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned.

It is believed that this paper is being filed timely, and no extensions of time are required. In the event any additional extensions of time are necessary, the undersigned hereby authorizes the requisite fees to be charged to Deposit Account No. 501668.

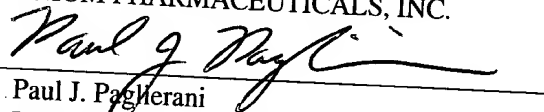
Entry of the remarks made herein is respectfully requested.

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Respectfully submitted,

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